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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,813	10/30/2003	Donald H. Osterberg JR.	021756-067000US	2479
51206 7590 03/07/2011 Kilpatrick Townsend & Stockton LLP/Oracle Two Embarcadero Center 8th Floor San Francisco, CA 94111-3834				
EXAMINER				
WHIPPLE, BRIAN P				
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2448				
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03/07/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/698,813

**Applicant(s)**

OSTERBERG, DONALD H.

**Examiner**

Brian P. Whipple

**Art Unit**

2448

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-9 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-2, 5-9, and 21-27 are pending in this application and presented for examination.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/4/10 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments filed 12/1/09 have been fully considered, but they are not persuasive. As stated in the advisory action mailed on 12/16/09, the applicant's arguments amount to a general allegation of patentability as the applicant has presented the bulk of the claim in quotes and then simply stated none of the references disclose the subject matter. Additionally, the applicant is directed to the examiner's response in the Office action mailed on 10/1/09 (¶ 3, in which the examiner addresses the applicant's piecemeal analysis of individual references, wherein the rejection is based on a combination of references, and the

applicant's general allegation of patentability)The applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 5-9, and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminski et al. (Kaminski), U.S. Publication No. 2005/0044155 A1, in view of Goldman, U.S. Publication No. 2003/0233418 A1, and further in view of Quine et al. (Quine), U.S. Publication No. 2002/0023138 A1.

6. As to claim 1, Kaminski discloses an unsolicited e-mail internet protocol source address verification method (Abstract, ln. 1-3) comprising:

receiving at an e-mail authorization system from a source a request for authorization to forward an electronic mail message, the request identifying an address of the source of said request ([0032], ln. 1-2; [0034], ln. 1-4 and 9-15);

authorizing the request with the e-mail authorization system including generating an authorization indicator that indicates the source of said request for authorization ([0035], ln. 1-3 and 8-10; [0036], ln. 10-12);

responding to the source of said request for authorization with the e-mail authorization system ([0035], ln. 1-3 and 8-10), wherein a response to said request for authorization includes the authorization indicator ([0036], lines 10-12) and wherein the authorization indicator is sent from the e-mail authorization system to the address of the source request ([0036], ln. 10-12);

receiving the electronic mail message at a destination (Fig. 10, item 450), the electronic mail message including an address for a source of the electronic mail message ([0035], ln. 1-3 and 8-10; [0036], ln. 10-12) and the authorization indicator ([0036], ln. 12-14); and

handling receipt of said electronic mail message at a destination (Fig. 10, item 450).

Kaminski is silent on the authorization indicator is sent after authorization; and

verifying the address for the source of the electronic message included in the received said electronic mail message against the authorization indicator.

However, Goldman discloses verifying the address for the source of the electronic message included in the received said electronic mail message against the authorization indicator ([0063]; the purported address is verified against itself or the manager's address through the use of an authorization request for indicating authorization).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kaminski by verifying the source address of an electronic mail message against the given address or a manager's address as taught by Goldman in order to detect spoofed sender addresses, the occurrence of which typically indicates junk e-mail (Goldman, [0063], lines 11-14) and/or allow a manager to control whom is classified as unauthorized in a mail system (Goldman: [0063]).

Kaminski and Goldman are silent on the authorization indicator is sent after authorization.

However, Quine discloses the authorization indicator is sent after authorization ([0101] – [0102]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Kaminski and Goldman in the aforementioned manner as taught by Quine in order to indicate a change, related to email addressing, to authorized users (Quine: [0101]).

7. As to claim 2, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including said request is initiated by a source of said electronic mail message (Kaminski: Figure 7, item 258 of SENDER'S MAIL CLIENT 14; [0034], lines 9-15) and

said request asks a simple mail transfer protocol agent of the e-mail authorization system for authorization to send an electronic mail message to a destination serviced by said simple mail transfer protocol agent (Kaminski: [0036], lines 1-4).

8. As to claim 5, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including performing at the email authorization system an indication generator process in which an authorization indicator is generated (Kaminski: Figure 7, item 268; [0036], lines 10-12).

9. As to claim 6, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 5, including said authorization indicator is a unique bit string and further identifies the email authorization system (Kaminski: [0036]; [0038]; [0044], lines 1-3; [0045], lines 8-11).

10. As to claim 7, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including tracking said source address with the e-mail authorization system (Kaminski: [0036], lines 4-9).

11. As to claim 8, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 2, including inserting an entry into said electronic mail message with the simple mail transfer agent indicating the address the authorization indicator is sent to before forwarding said electronic mail message from the e-mail authorization system to the destination (Kaminski: [0036], ln. 1-4; [0046], lines 13-20).

12. As to claim 9, Kaminski, Goldman, and Quine disclose the invention substantially as in parent claim 1, including extracting a request source address from said request (Kaminski: [0034], lines 9-15; [0035], lines 1-3); and

utilizing said request source address as a destination address in a header file of a return package including authorization indicator information (Kaminski: [0022], lines 20-23; [0025], lines 3-4; [0035], lines 1-3; [0036], lines 10-12).

13. As to claims 21-22 and 25, the claims are rejected for reasons similar to claim 1 above.



14. As to claim 23, the claim is rejected for reasons similar to claim 2 above.
15. As to claim 24, the claim is rejected for reasons similar to claim 8 above.
16. As to claim 26, the claim is rejected for reasons similar to claim 6 above.
17. As to claim 27, the claim is rejected for reasons similar to claim 7 above.

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple  
/Brian P. Whipple/  
Examiner, Art Unit 2448  
3/3/11